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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,535	12/01/2000	Jae Chang Jung	000939-078800US	5110

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TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/07/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/728,535

Applicant(s)

JUNG ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2003 .
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Examiner's finding of Jung et al with a publication date of September 2000 (Volume date January 2001) requires the following new rejections. Tomihari et al (JP 2-263811) has also been reconsidered in view of the English translation obtained. This prior art would have been properly applied in the first Office Action. Therefore, the finality of the last Office action is withdrawn.

2. The examiner notes for the record that applicant's amendments to the instant claim 1 prior art rejections over Tanabe et al and Gibson et al no longer apply. The requirement that both alkyl acrylate and acrylic acid be used to derive the instant composition limits the instant invention to one outside the scope of Tanabe et al and Gibson et al. The examiner does not address applicants' arguments with respect to the prior rejections beyond this analysis because the limitation is sufficient to overcome the prior art without further reason.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 9 and 12-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Jung et al (Polymer published September 2000 as set forth in the Journal table of contents front page). Jung et al is a different inventive entity than the instant application even though one name may be in common, i.e. J.C. Jung and Jae Chang Jung. The publication date is given as September 2000 for the Polymer article which is before the volume date of January 2001 which is before the filing date of the application which is December 1, 2000. The overcoat compositions of Jung et

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al are poly acrylic acid co methyl acrylate and mixed with L-proline as an amine, i.e. a basic compound, and water is the solvent. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

5. Claims 1-2, 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomihari et al (PTO 03-215 which is an English translation of Tomihari et al (JP 02-263811) optionally further evidenced by Morpholine (Environmental Health Criteria 179, 1996). The instant compositions of claims 1-12 are required to be comprised of a an over-coating resin derived from a mixture of acrylic acid, and alkyl acrylate, a solvent and a basic compound. With respect to instant claims 1, 2 and 5-8, the working examples 1-2 of Tomihari et al as set forth in PTO 03-215 anticipate the instant composition wherein the basic compound used is ammonia in Working Example 1 and morpholine in Working Example 2. The basic compound is used to derive the coating composition of Tomihari et al and morpholine as evidenced by Morpholine on page 20 has a pKa (conjugated acid) of 8.33 at 25 degrees C thus meeting the limits of instant claim 4 and the examiner notes that a certain portion of morpholine would remain even after neutralization in the composition of Tomihari et al. However, the examiner notes that the claim language states the instant composition is derived from the components set forth, therefore the use of a base to form the composition is sufficient to meet the claim requirements.

6. Claims 1-2, 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomihari et al (PTO 03-215 which is an English translation of Tomihari et al (JP 02-263811). The instant compositions of claims 1-12 are required to be comprised of a an over-coating resin derived from a mixture of acrylic acid, and alkyl acrylate, a solvent and a basic compound. The

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compositions of Tomihari et al teach the instant compositions wherein the not preferred amine is triethanol amine used is set forth on the top of page 8. The copolymers used are generically disclosed as copolymers of (a) an alpha, beta-monoethylenic unsaturated acid and (b) an ester of acrylic acid or methacrylic acid as taught on page 5. On page 6, said ester is described as a saturated aliphatic monhydric alcohol ester thus an alkyl ester. Thus, all of the esters of Tomihari are the alkyl esters required by the instant invention. Said acids are inclusive of acrylic acid among six listed on page 5. However, the working examples are all drawn to acrylic acid copolymers. Tomihari et al have no working examples using acrylic acid and alkyl acrylates with triethanol amine as the amine. However, with respect to instant claims 1-2, and 4-11, the use of the acrylic acid and alkyl acrylates in the working examples as the only examples of copolymers actually given in the Tomihari et al reference makes their use obvious with the less preferred listed triethanol amine to obtain a water resistant coating as desired by Tomihari as taught on page 3 wherein their invention is directed to forming a composition or aqueous protection suitable for preventing primary corrosion of coated or plated surfaces. The examiner notes for the record that an obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use. See particularly *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130 (Fed.Cir. 1994). The examiner notes that claim 10 is included in this rejection only because the choice of amine in claim 9 is not limited to the tetraalkylammonium hydroxide salts. Thus, the limits of claim 10 do not apply to the choice of tri(hydroxyalkyl) amines. If claim 10 were written to limit the amine compound given in claim 9 to the list given in claim 10 then claim 10 would not have been included in this rejection.

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7. Applicant's arguments filed June 28, 2002 have been fully considered but they are not persuasive. Applicants argued against Tomihari et al in a previous response because an English translation was not available. The examiner has now obtained such a translation. Applicants further argued the basic compound would not be present in the compositions of Tomihari et al because of the neutralization. The examiner holds the claim language sets forth deriving the composition from the basic compound. The Tomihari et al reference does this. Also, in the alternative, the examiner notes that the amines of Tomihari et al would not be added in excess to form full neutralization of the copolymers used leaving some base present. Thus, workers of ordinary skill in the polymer arts would have recognized that some base would be present in the compositions of Tomihari et al. So, the composition of Tomihari et al is derived from a basic compound and would after full neutralization have traces of basic compound present in the final coating compositions. Claim 3 is not made obvious or anticipated by Tomihari et al because there are no copolymers made with only acrylic acid and methyl acrylate used by Tomihari et al. the working examples are all terpolymers and thus excluded by the copolymers set forth in instant claim 3. Thus, the arguments already presented do not act to remove the translated Tomihari et al prior art.

8. Claims 14-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Papers No. 5 and 7. The examiner notes the issue of rejoinder upon allowance of claim 1, but finds such consideration premature in view of the rejections now set forth.

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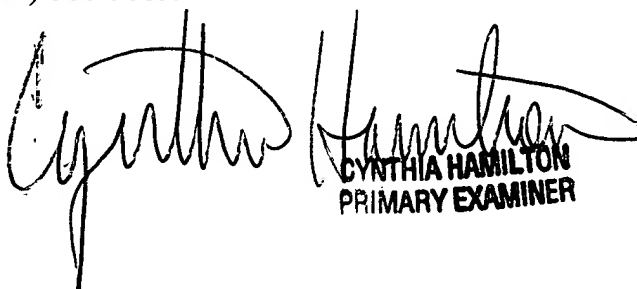
9. The examiner accepts applicants arguments with respect to what is a basic compound and removes rejections under 35 USC 112 second paragraph. The examiner notes however that the instant composition is not required to be basic only that a basic compound be used to make up the composition.

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on (703) 308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.*

*Any inquiry of papers not received regarding this communication or earlier communications, or of a general nature or relating to the status of this application or proceeding should be directed should be directed to the Customer Service Center of Technology Center 1700 whose telephone number is (703) 306-5665.*

Cynthia Hamilton  
March 5, 2003



CYNTHIA HAMILTON  
PRIMARY EXAMINER